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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,185	12/26/2000	Gilles Philippus van Wezel	4666US	6157
24247	7590	03/30/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			RAO, MANJUNATH N	
			ART UNIT	PAPER NUMBER

1652

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/749,185

**Applicant(s)**

VAN WEZEL ET AL.

**Examiner**

Manjunath N. Rao, Ph.D.

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,8,9,11,14-19 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,9,11,14-19 and 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

Claims 1, 3, 8-9, 11, 14-19, 29-33 are currently pending and under consideration in this application.

Applicants' amendments and arguments filed on 2-2-04, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Specifically Examiner has withdrawn the rejections under 35 U.S.C. 112, 1st and 2<sup>nd</sup> Paragraph in view of cancellation of some claims and claim amendments submitted by the applicant.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 30 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of producing a recombinant actinomycete by transforming said actinomycete such as *Streptomyces* lacking a detectable endogenous SsgA using the polynucleotide with SEQ ID NO:1 encoding a polypeptide with SEQ ID NO:3 for enhancing septation and fragmentation of said bacterium, does not reasonably provide enablement for such a method using any means (i.e., any DNA). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

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Factors to be considered in determining whether undue experimentation is required, are summarized in *In re Wands* (858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)) as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claim(s).

Claim 30 so broad as to encompass the use of any DNA having the capability to encode any protein and isolated from any source or derived from any source including derivatives, variants, mutants and recombinants in the above method. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of DNA sequences that are broadly encompassed by the claims.

Applicants propose to use the above polynucleotides for the process of making transformants with a specific phenotypical characteristic. Since the nucleotide sequence determines the type of protein and the ultimate function of the encoded protein and thereby the phenotype of the transformant changing or using any means (i.e., any nucleotide sequence) as proposed by the applicants and/or addition of substantial amount of additional nucleotide sequence unrelated to the nucleic acid sequence of SEQ ID NO:1 may not lead to desired function of said means (i.e., said polynucleotides). This is because the changes suggested by the applicants will result in the use of an enormous number of nucleotide sequences that may or may not have the desired function. However, in this case the disclosure is limited to the use of a single nucleotide sequence with SEQ ID NO:1.

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While recombinant and mutagenesis techniques are known, it is not routine in the art to screen for multiple substitutions or modifications of nucleotides, as encompassed by the instant claims, and the base changes within a nucleic acid's sequence can be made with a reasonable expectation of success in obtaining the desired activity/utility are limited and the result of such modifications is unpredictable. In addition, one skilled in the art would expect any tolerance to modification for a given DNA to diminish with each further and additional modification, e.g. multiple substitutions.

The specification does not support the broad scope of the claims which encompass all modifications and fragments of any DNA from any source because the specification does not establish: (A) regions of the DNA sequence which may be modified without effecting the above mentioned activity/utility; (B) the general tolerance of ssgA DNA sequence to modification and extent of such tolerance; (C) a rational and predictable scheme for modifying any DNA with an expectation of obtaining the desired biological function and utility; and (D) the specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including the use of any DNA or its derivative or fragment as having the above property. The scope of the claims must bear a reasonable correlation with the scope of enablement (In re Fisher, 166 USPQ 19 24 (CCPA 1970)). Without sufficient guidance, determination of DNAs having the desired biological characteristics is unpredictable and the

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experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See *In re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988).

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim is directed to a method of producing a filamentous bacterium using a genus of polynucleotides that have not been described in the specification.

The specification does not contain any disclosure of the structure of all such “means” (polynucleotides or genes) for enhancing septation and fragmentation. The genus of the “means” is a large variable genus with the potentiality of having different structures. Therefore, many structurally unrelated “means” (i.e., DNAs) are encompassed within the scope of these claims, including partial DNA sequences. The specification discloses only a single species, i.e., SEQ ID NO:1 of the claimed genus which is insufficient to put one of skill in the art in possession of the attributes and features of all species within the claimed genus. Therefore, one skilled in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 8-9, 11, 14-15, are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamoto et al. (Microbiology, April 1997, Vol. 143:1077-1086, listed by the applicant in the IDS, also see DNA and amino acid sequence alignment with database GenEmbl Accession No. D50051 and SPTREMBL\_19, Accession No. P95753, May 1, 1997). This rejection is based upon the public availability of a printed publication one year before the effective filing date of the instant application. Claims 1, 3, 8-9, 11, 14-15 of the instant application are drawn to a method for producing a filamentous recombinant bacterium exhibiting reduced branching and fragment septation during growth or exhibiting enhanced fragmentation during growth, wherein the method comprises transforming a filamentous bacterium which lacks detectable endogenous SsgA activity with a polynucleotide expressing SsgA activity and the sequence shown in SEQ ID NO:1, and wherein the polynucleotide is integrated into the bacterial genome or is a part of an episomal element, wherein the *ssgA* activity is inducible or repressible with a signal, wherein the filamentous bacterium is an actinomycete such as *Streptomyces* and wherein the filamentous bacterium produces a useful product such as an antibiotic.

Kawamoto et al. disclose an identical method using a polynucleotide which is 100% identical to SEQ ID NO:1, isolated from *S.griseus*, which when transformed into another actinomycete lacking detectable endogenous SsgA such as Strain NRRL B2682, results in

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formation of septate form of the bacterium, wherein the polynucleotide is integrated into the genome or resides as an episomal element, wherein the expression of the gene product is inducible and wherein the actinomycete bacterium produces a useful product such as an antibiotic, streptomycin and wherein the polynucleotide encodes a polypeptide comprising SEQ ID NO:3 and wherein the polynucleotide with SEQ ID NO:1 encoding a polypeptide with SEQ ID NO:3 works as a means for enhancing septation and fragmentation of the transformed bacterium and wherein the transformed bacterium is selected from a group which includes *S.griseus*. Thus Kawamoto et al. anticipate claims 1, 3, 8-9, 11, 14-15 of this application as written.

In response to the previous Office action, applicants have traversed the above rejection arguing that Kawamoto et al. does not anticipate claim 1 since Kawamoto et al. does not disclose each and every element of claim 1. Applicants specifically argue that Kawamoto et al. does not disclose providing a filamentous actinomycete bacterium lacking detectable endogenous SsgA as required to anticipate claim 1 and refer the Examiner to figure 2(a), (b) and (c) in the reference. Applicants argue that Kawamoto et al. depict Western blot panels in these figures having bands which indicate the production of SsgA showing that there was detectable levels of SsgA. Examiner respectfully disagrees with such an argument. This is because Kawamoto et al. disclose a strain of Streptomyces NRRL B2682 which sporulates in liquid medium but produces profuse branches and does not sporulate in rich medium. Kawamoto et al. also disclose that the very same bacterium forms septum only after transformation with *ssgA*. It is clear from this information that such a strain was not producing detectable levels of SsgA endogenously before transformation, because if detectable levels of SsgA was being produced by said strain, it would



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have formed septum and not spores or filaments. Furthermore it is clear from the figure 2 panels that said strain of Kawamoto et al. did not produce endogenous SsgA since there is no signal in the first 16 hours of incubation after transformation. This clearly shows that there was no endogenous synthesis of SsgA. Examiner also takes the position that such a characteristic was inherent in that strain. Therefore, contrary to applicant's argument, Kawamoto et al. discloses a filamentous actinomycete bacterium lacking detectable endogenous SsgA as required to anticipate claim 1. Hence the above rejection is maintained. Examiner has withdrawn the rejection as it applied to claims 30-33 in view of claim amendment limiting to specific species of Streptomyces.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamoto et al. as applied to claims 1, 3, 8-9, 11, 14-15 above, and further in view of the common knowledge in the art for making recombinant bacterium and expressing heterologous proteins using the same. Claims 16-19, 30-33 are drawn to a method of making a heterologous protein using the filamentous bacterium produced by the method of claims 1, 3-9, 11, 13-15, 29-34 as well as method of making recombinant bacterium with enhanced septation and fragmentation. The method of making heterologous recombinant proteins by transforming host

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cells is well known in the art of molecular biology. The method of making an actinomycete such as *S.griseus* with enhanced septation and fragmentation is taught by Kawamoto et al. Therefore with a strain of filamentous bacterium which undergoes fragmentation thereby increasing its total cell number and in turn increasing the production of any proteins that it produces, it would have been obvious to one of ordinary skill in the art to use such a filamentous bacteria to produce a heterologous protein by transformation techniques. One of ordinary skill in the art would have been motivated to do so as filamentous bacteria which are generally easily cultivated on a larger scale to produce large amounts of heterologous protein when available in fragmented form would be much more amenable for large scale cultivation because it overcomes the problems of clumping of mycelial masses thus allowing better nutrient and oxygen transport resulting in more growth and production of the intended product. One of ordinary skill in the art would have a reasonable expectation of success since Kawamoto et al. provide the technique for making such fragmented bacteria and the art provides techniques for transformation of such cells to produce any heterologous polypeptide by transformation.

Similarly, with the teaching of Kawamoto et al. that *S.griseus* can be transformed with a polynucleotide encoding SsgA, in hand it would have been obvious to those skilled in the art to apply the same method to other species of Streptomyces such as *S.coelicolor* or *S.lividans* etc.. One of ordinary skill in the art would be motivated to do so as these are all industrially important microorganisms. One of ordinary skill in the art would have a reasonable expectation of success since Kawamoto et al. clearly demonstrate the increased septation and fragmentation in *S.griseus*.

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Therefore the above claims would have been *prima facie* obvious to one of ordinary skill in the art.

In response to the previous Office action, applicants have traversed the above rejection arguing that as Kawamoto et al. does not anticipate claim 1, claims 16-19 depending therefrom remains non-obvious. However, contrary to such a conclusion by the applicant, examiner has shown that Kawamoto et al. does anticipate claim 1 and renders claims 16-19 and 30-33 *prima facie* obvious to those skilled in the art.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

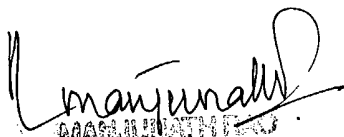
### ***Conclusion***

None of the claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

  
MANJUNATH N. RAO  
PATENT EXAMINER  
Manjunath N. Rao  
March 24, 2004